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Attorney Docket: 678-1252

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPLICANT(S):** Young-Se KIM

**EXAMINER:** Nguyen, Huy D.

**SERIAL NO.:** 10/646,918

**GROUP ART UNIT:** 2681

**FILED:** August 22, 2003

**DATED:** September 13, 2006

**FOR: PORTABLE DIGITAL COMMUNICATION DEVICE**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313

**TRANSMITTAL OF AMENDED APPEAL BRIEF**

Sir:

This Amended Appeal Brief is being submitted in response to the Notification of Non-Compliant Appeal Brief in accordance with the requirements of 37 CFR 41.37 dated August 17, 2006.

Respectfully submitted,

Paul J. Farrell  
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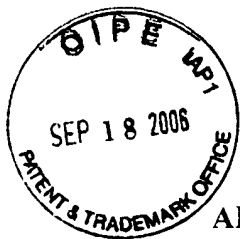
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Dated: September 13, 2006

  
Michael J. Musella



Attorney Docket No.: 678-1252 (P11372)

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**AMENDED APPEAL BRIEF**

Sir:

**REAL PARTY IN INTEREST**

The real party in interest is Samsung Electronics Co. Ltd., the assignee of the subject application, having an office at 416, Maetan-dong, Yeongtong-gu, Suwon-si, Gyeonggi-do, Republic of Korea.

**RELATED APPEALS AND INTERFERENCES**

To the best of Appellant's knowledge and belief, there are no currently pending related appeals, interferences or judicial proceedings.

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**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (a)**

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Dated: September 13, 2006

  
Paul J. Farrell

## **STATUS OF CLAIMS**

Of Claims 1-6, Claims 1-3, 5 and 6 stand finally rejected and constitute the claims on appeal, and Claim 4 has been found to be allowable if rewritten to include the subject matter of the base claim and any intervening claims. A copy of the appealed claims is contained in the Claims Appendix.

For the purposes of this appeal, Claims 2, 3, 5 and 6 stand or fall together with Claim 1. Independent Claim 1 is an apparatus claim.

## **STATUS OF AMENDMENTS**

A Response dated April 25, 2006 was filed subsequent to the final rejection dated January 25, 2006 without amendment to claims. Thus, Claims 1-6 as filed are pending for the purposes of this appeal and are contained in the Claims Appendix.

## **SUMMARY OF CLAIMED SUBJECT MATTER**

The present application relates a portable digital communication device having a main housing, and first and second key pads, which open and close on the main housing, while continuously facing a top surface of the main housing. Thus, the portable digital communication device of the present application provides facilitation of key manipulation relative to the first and second key pads using fingers of both hands. Here, the term “facilitation of key manipulation” includes speed and accuracy of key manipulation when a user manipulates keys; in other words, when a user presses down keys. More particularly, the portable digital communication device of the present application is designed so that the first and second key pads are mounted to slide toward or away from

each other so as to promote convenience of the key manipulation using both hands (see Specification, Page 4, Lines 24 through Page 5, Line 4; and FIGs. 1-4).

As defined by Claim 1, the present invention is drawn to a portable communication device having a main housing provided with a display unit on a top surface thereof, a first key pad being capable of sliding on the top surface of the main housing in one direction relative to the display unit so as to open and close one side of the display unit, and a second key pad being capable of sliding on the top surface of the main housing in the other direction relative to the display unit so as to open and close the other side of the display unit and being capable of sliding toward or away from the first key pad (see Specification, Page 5, Lines 6-24; and FIGs. 1-4).

#### **GROUND FOR REJECTION TO BE REVIEWED ON APPEAL**

Claims 1, 2, 5 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,748,249 (hereinafter Eromaki et al.), and Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Eromaki et al. in view of U.S. Publication No. 2003/0143961 (hereinafter Humphreys et al.).

## ARGUMENT

Claims 1, 2, 5 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,748,249 (hereinafter Eromaki et al.), and Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over Eromaki et al. in view of U.S. Publication No. 2003/0143961 (hereinafter Humphreys et al.).

### **I. EROMAKI ET AL. FAILS TO RENDER OBVIOUS THE INVENTION AS CLAIMED IN CLAIM 1**

Independent Claim 1 was said to be rendered unpatentable by Eromaki et al. (See, Paragraph 2, at Page 2, of the Office Action dated January 25, 2006).

It is alleged that Eromaki et al. teaches each and every limitation of Claims 1-3, 5 and 6, except that “Eromaki et al. does not teach that the second lid includes a keyboard” which the Examiner states is taught by the knowledge generally available to one of ordinary skill in the art (e.g., see, Office Action dated January 25, 2006, Page 2, Paragraph 1).

The present application relates to the portable digital communication device which is designed so that the first and second key pads are mounted to slide toward or away from each other so as to promote convenience of the key manipulation using both hands

(see. Specification, Page 4, Lines 24 through Page 5, Line 4; and FIGs. 1-4). Accordingly, a user can conveniently manipulate the claimed double key pads being capable of sliding on the display which is located at the open-close portion of the top surface while chatting, playing a game, or inputting complicated data for transmission of an e-mail using the fingers of both hands (see Specification, Page 5, and FIGs. 2 and 4).

Accordingly, Eromaki et al. fails to teach or even fairly suggest the recitations of Claim 1.

**a. It is the position of the Examiner that it would be obvious in the knowledge generally available to one of ordinary skill in the art to include a keyboard on the second lid.**

Claim 1 recites a portable communication device having a main housing provided with a display unit on a top surface thereof, a first key pad being capable of sliding on the top surface of the main housing in one direction relative to the display unit so as to open and close one side of the display unit, and a second key pad being capable of sliding on the top surface of the main housing in the other direction relative to the display unit so as to open and close the other side of the display unit and being capable of sliding toward or away from the first key pad.

Regarding independent Claim 1, the Examiner admits that Eromaki et al. does not teach that the second lid (SL2) includes a keyboard. The Examiner then states that it would have been obvious to one having ordinary skill in the art at the time the invention

was made to include a keyboard on the second lid (SL2) in order to have space for more functional keys or to transfer some of the keys from KB1 to the SL2, so that the keys can be made bigger for user convenience. However, it is respectfully submitted that the Examiner makes an unsupported statement regarding the obviousness of the limitations contained in the claims. The Examiner is required to provide support for each and every position used to reject a claim limitation. A recent case decided by the U.S. Court of Appeals for the Federal Circuit specifically addresses this issue. The case, *In Re Lee*, 61 U.S.P.Q.2d 1430 (CAFC 2002), holds “‘common knowledge and common sense’...may not be substituted for evidence.” The Examiner has provided no evidence to support his broad and sweeping “obviousness” rejections. Furthermore, it does not appear to be well known since the facts asserted to be well known should be capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418 (CCPA 1970) Rather, it would be hindsight from the teachings of the present invention. Furthermore, the claimed double key pads being capable of sliding on the display are significant because it provides a patentable distinction and are not merely provided in order to have space for more functional keys or to transfer some of the keys from the first lid to the second lid for bigger sized keys, but in order to provide convenience of key manipulation while chatting, playing a game, or inputting complicated data for transmission of an e-mail using the fingers of both hands. The claimed double key pads being capable of sliding on the display play a vital role in the distinguishing features of the invention.

**b. The Examiner fails to provide any motivation for having first and second key pads being capable of sliding on the display.**

According to the present invention as recited in Claim 1, the first and second key pads slide on the display unit on the top surface of the main housing in order to open and close the display unit, respectively. More particularly, as defined by the Specification of the present application, the top surface of the first and second key pads is provided with at least 15 to 20 keys, respectively, which may not allow the user to view the display through the first and second key pads (see Specification, Page 6, Lines 18-24).

In contrast to Claim 1, Eromaki et al. teaches that the second lid (SL2) is preferably transparent, more preferably of shock-resistant transparent plastic to protect the display, and when it is on top of the display, it acts as a lens for the part of the display which is visible through the second lid (SL2) (Col. 3, Lines 45-49 of Eromaki et al.). Eromaki et al. does not provide any motivation for having first and second key pads being capable of sliding on the display because having double key pads would defeat Eromaki et al.'s purpose, where the second lid is provided only to protect the display and allow the user to view the display through the second lid. This argument was presented to the Examiner in the November 9, 2005 Response.



**c. The claimed double key pads being capable of sliding on the display is not mere duplication of parts.**

In the “Response to Argument” section of the present Office Action (page 2) the Examiner further states that it has been held that duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. However, a more pertinent case, *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), holds “mere duplication of parts has no patentable significance unless a new and unexpected result is produced.” The claimed double key pads being capable of sliding on the display play a vital role in the distinguishing features of the invention in order to provide convenience of key manipulation while chatting, playing a game, or inputting complicated data for transmission of an e-mail using the fingers of both hands, rather than mere duplication of parts.

Accordingly, for at least the above-stated reasons, Eromaki et al. does not render obvious Claim 1.

well known should be capable of instant and unquestionable demonstration as being well-known. *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418 (CCPA 1970) Further, Eromaki et al. does not provide any motivation for having first and second key pads being capable of sliding on the display because having double key pads would defeat Eromaki et al.’s purpose. The Examiner has failed to show that all of the recitations of Claim 1 are taught or suggested by Eromaki et al. Accordingly, the Examiner has failed to make out a prima facie case for an obviousness rejection.


## CONCLUSION

As the Examiner has made an unsupported statement regarding the obviousness of the limitations in Claim 1 and failed to provide any motivation for having first and second key pads being capable of sliding on the display, the rejection of Claim 1 must be reversed. In particular, the case, *In Re Lee*, 61 U.S.P.Q.2d 1430 (CAFC 2002), holds “common knowledge and common sense...may not be substituted for evidence.” The Examiner has provided no evidence to support his broad and sweeping “obviousness” rejections. In addition, it does not appear to be well known since the facts asserted to be independent Claim 1 is allowable.

Independent Claim 1 is not rendered unpatentable by Eromaki et al. Thus, independent Claim 1 is allowable.

Accordingly, dependent Claims 2-6 are allowable because of their respective dependence upon independent Claim 1.

Dated: July 24, 2006

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## CLAIMS APPENDIX

1. (Original) A portable digital communication device comprising:  
a main housing provided with a display unit on a top surface thereof;  
a first key pad being capable of sliding on the top surface of the main housing in a first direction relative to the display unit so as to open and close a first side of the display unit; and

a second key pad being capable of sliding on the top surface of the main housing in a second direction relative to the display unit so as to open and close a second side of the display unit and being capable of sliding toward and away from the first key pad.

2. (Original) The portable digital communication device according to claim 1, wherein the display unit is located in an intermediate portion of the top surface of the main housing.

3. (Original) The portable digital communication device according to claim 1, wherein the main housing comprises:

at least one functional key located on a side surface thereof;  
a headphone jack and a volume adjusting button mounted on a side surface thereof; and  
a battery pack disposed on a bottom surface thereof.

4. (Original) The portable digital communication device according to claim 1,

wherein the main housing comprises:

a cylindrical lens housing and a shutter, the cylindrical lens housing having a camera lens exposed between a side surface of the main housing and a bottom surface of the main housing, the shutter neighboring the lens housing, the main housing having a rotation axis which is parallel to and spaced a predetermined distance from a virtual plane on which the first and second key pads linearly move, the camera lens being rotatably mounted between the side surface and the bottom surface.

5. (Original) The portable digital communication device according to claim 1, wherein the first key pad further comprises a microphone on the top surface thereof, and the second key pad is provided with a speaker on the top surface thereof.

6. (Original) The portable digital communication device according to claim 1, wherein the first and second key pads slide toward and away from each other on the top surface of the main housing to open and close the display unit, so that the display unit is fully opened when the first and second key pads move away from each other to a maximum extent, and the display unit is fully closed when the first and second key pads move toward each other to a maximum extent.

## **EVIDENCE APPENDIX**

There is no evidence submitted pursuant to 37 C.F.R. §1.130, §1.131, or §1.132, or entered by the Examiner and relied upon by the Appellant.

## **RELATED PROCEEDINGS APPENDIX**

There are no known decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 C.F.R. §41.37.